

REMARKS

Reconsideration of this application, as presently amended, is respectfully requested. Claims 1, 4-16 and 19 are pending in this application, claims 2-3, 17-18 and 20 having previously been cancelled. Claims 1, 4-16 and 19 are rejected.

Claim Rejection – 35 U.S.C §112, second paragraph

Claims 1-18 were rejected under 35 U.S.C. §112, second paragraph, for alleged indefiniteness. More specifically, the Examiner asserts that the claimed “means for transmitting an electronic mail” is indefinite under §112, second paragraph, because the corresponding structure is not described in the specification. For the reasons set forth below, this rejection is respectfully traversed.

It is noted that in the previous Office Action, claims 1-18 were rejected under 35 U.S.C. §112, second paragraph, because the specific structures which perform the functions of the claimed “means for transmitting,” “means for storing,” and “means for forming” were *allegedly* not described in the specification. In the current Office Action, the Examiner has withdrawn the §112(2) rejection with respect to the language “means for storing” and “means for forming” (see page 2, Item 3 of Office Action). However, the Examiner maintains the §112(2) rejection with respect to the language “means for transmitting.”

Initially, the Examiner is requested to keep in mind that it is well-known that electronic mail (e-mail) is transmitted from, e.g., personal computers.

As was discussed in the Amendment filed on May 30, 2007, the disclosure of the structure corresponding to the means-plus-function language does not have to be explicit. Instead, if one skilled in the art would be able to identify the structure, material or acts from the description in the specification for performing the recited function, then the requirements of 35 U.S.C. §112, second paragraph, are satisfied. See *In re Dossel*, 115 F.3d at 946-47, 42 USPQ2d at 1885. Further, the disclosure of the structure (or material or acts) may be implicit or inherent in the specification if it would have been clear to those skilled in the art what structure (or material or acts) corresponds to the means (or step)-plus-function claim limitation. *In re Dossel*, 115 F.3d 942, 946-47, 42 USPQ2d 1881, 1885 (Fed. Cir. 1997).

It is submitted that the present specification clearly describes the structure corresponding to the “means for transmitting an electronic mail.” For example, the first page of the specification states “An advantage of the present invention is to provide *an electronic mail client and a program for the electronic mail client which can transmit an electronic mail* even when a failure is generated in a mail server.” See page 1, lines 17-19 of application specification. Further, page 1, lines 25-26 of the application specification describes “An electronic mail client of the present invention is a client which *transmits* an electronic mail via a mail server.” Still further, Fig. 1 and the description thereof on page 5, lines 8-9 of the specification states “...the mail clients 2, 18 are an Internet facsimile machine, a personal computer or the like.”

In view of the above discussion, it is submitted that the specification makes it clear to those skilled in the art that the mail clients 2, 18 (e.g., facsimile machine, personal computer or the like) are structure corresponding to the claimed “means for transmitting an electronic mail.”

Accordingly, reconsideration and withdrawal of the rejection under §112, second paragraph, are respectfully requested.

Claim Rejections – 35 U.S.C. §103

Claims 1, 4-8, 13 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Katsuji** (JP Pub. No. 11-164121, previously cited) in view of **Postel** (“RFC 821: Simple Mail Transfer Protocol,” previously cited). Claims 9-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Katsuji** in view of **Postel**, and further in view of **Glasser et al.** (USP 5,956,715, previously cited). Claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable over **Katsuji** in view of **Postel**, and further in view of **Shimano** (USP 54,835,730, previously cited). Claims 14-16 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Katsuji** in view of **Postel**, and further in view of **Witek** (USP 5,461,488, previously cited).

Initially, it is noted that independent claim 1 has been amended to recite “a bypass permission table which stores data indicating whether or not it is possible for the means for transmitting to bypass the selected mail server and the selection means select the mail server of next in priority order for transmitting the electronic mail, wherein the bypass permission table can be formed and rewritten.” Claim 19 has been amended similarly. This change includes features similar to those recited in claim 10. Accordingly, it is submitted that the amendments to claims 1 and 19 do not raise new issues requiring further consideration and/or search, and should be entered and considered at this time.

The Examiner has withdrawn the previous rejection over the **Katsuji** reference alone, and recognizes that **Katsuji** does not disclose a “determining means for determining whether to establish a connection again with the mail server that was selected at the time of failure in the transmission of electronic mail, or to cancel the transmission.” See Office Action, page 5, Item 10. The Examiner relies on **Postel** to teach the features missing from **Katsuji**.

The **Katsuji** reference was discussed in detail in the previous response, and that discussion is hereby incorporated by reference.

The Examiner relies on the **Postel** reference, which is a paper discussing the Simple Mail Transfer Protocol (SMTP), to teach the features missing from the **Katsuji** reference. More specifically, the Examiner relies on a discussion of SMTP reply codes, which are sent by the receiver SMTP in response to an SMTP command, to teach the claimed “determining means for determining whether to establish a connection again with the mail server that was selected at the time of failure in the transmission of electronic mail, or to cancel the transmission.”

As noted above, claim 1 has been amended to recite “a bypass permission table which stores data indicating whether or not it is possible for the means for transmitting to bypass the selected mail server and the selection means select the mail server of next in priority order for transmitting the electronic mail, wherein the bypass permission table can be formed and rewritten.” Claim 19 has been amended similarly.

The Examiner cites **Glasser et al.** to teach the claimed bypass permission table. Specifically, in Items 28 and 30 of the Office Action, the Examiner cites the file system security

of Windows 95, specifically, access permissions related to file folders to teach the bypass permission table (see col. 4, lines 43-65 and col. 10, lines 63-65).

However, it is respectfully submitted that the **Glasser et al.** system is related to security, such as for file access, and regulates whether there is permission to read files to a folder, write files to a folder, create files and folders, delete files and folders, etc. The **Glasser et al.** system does not relate to bypassing, and particularly, does not relate to whether bypassing a mail server for transmitting an electronic mail is possible. Specifically, neither **Glasser et al.** nor any of the other cited references disclose or suggest “*a bypass permission table which stores data indicating whether or not it is possible for the means for transmitting to bypass the selected mail server and the selection means select the mail server of next in priority order for transmitting the electronic mail, wherein the bypass permission table can be formed and rewritten,*” as recited in claim 1 (and similarly in claim 19).

Further, **Glasser et al.** does not relate to a bypass permission table that is rewritable, such that management of electronic mail can be facilitated and mail servers for bypass can be prevented from being overused (see, e.g., page 8, lines 1-5 of the U.S. application).

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). It is respectfully submitted that the combination of references does not disclose or suggest all claimed elements. Therefore, the rejection under §103 is improper and should be withdrawn.

Application No. 10/632,863
Art Unit: 2142

Amendment under 37 C.F.R. §1.116
Attorney Docket No.: 030817

CONCLUSION

In view of the foregoing amendments and accompanying remarks, it is submitted that all pending claims are in condition for allowance. A prompt and favorable reconsideration of the rejection and an indication of allowability of all pending claims are earnestly solicited.

If the Examiner believes that there are issues remaining to be resolved in this application, the Examiner is invited to contact the undersigned attorney at the telephone number indicated below to arrange for an interview to expedite and complete prosecution of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP



William M. Schertler
Attorney for Applicants
Registration No. 35,348
Telephone: (202) 822-1100
Facsimile: (202) 822-1111

WMS/dlt